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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/528,819

01/13/2006

Peter Kacev

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INTELLECTUAL PROPERTY DEPARTMENT

SANTA MONICA, CA 90404

EXAMINER

TRIEU, THAI BA

ART UNIT

PAPER NUMBER

3748

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/528,819	<b>Applicant(s)</b> KACEV ET AL.	
	<b>Examiner</b> Thai-Ba Trieu	<b>Art Unit</b> 3748	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/25/2008</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This Office Action is in response to the Amendment filed on October 17, 2008.

Claims 1 and 5 were amended;

Claim 3 was cancelled; and

Claims 6-12 have been withdrawn from consideration.

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***Claims 1-2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pielstick (Patent Number 2,682,365).***

**Regarding claims 1-2,** Pielstick discloses a component for a turbocharger (1, 2, 3), the component including:

a housing (Not Numbered) defining a chamber for a predetermined part of the turbocharger (1, 2, 3), the housing (Not Numbered) being a compressor housing (a

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portion on the side of the compressor 1) of the turbocharger (1, 2, 3) and having an air inlet (via 9) for receiving uncompressed air and an air outlet (via 8) for discharging compressed air to an engine (15); and

a jacket (11, 12, 13, 14) surrounding a periphery and at least one side face of the housing, the jacket (11, 12, 13, 14) being arranged in a spaced relationship relative to an outer surface of the periphery and at least one side face of the housing to define a fluid path about the outer surface of the housing, the fluid path having a fluid inlet (13) and a fluid outlet (14) adapted for connection to an engine cooling system such that the fluid flow path is pressurized, in use;

in which the fluid path (11, 12, 13, 14) has the fluid outlet (14) situated at a furthestmost position on the housing from the fluid inlet (13) (See Figure, and Column 2, lines 13-40).

Note that in claim 1, the limitation “adapted for connection to an engine cooling system such that the fluid flow path is pressurized, in use” is an intended use recitation. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCCPA 1963).

Additionally, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

It is noted that in claim 1 the claim language "adapted to" makes optional but does not limit the claim 1 to the structure of the "water jacket of the compressor housing". See *MPEP* §2106 II C.

**Regarding claim 5**, Pielstick discloses a turbocharger (1, 2, 3) including a component comprising:

a housing (Not Numbered) defining a chamber for a turbocharger compressor (1), the housing having an air inlet (via 9) for receiving uncompressed air and an air outlet (via 8) for discharging compressed air to an engine (15); and

a jacket (11, 12, 13, 14) surrounding a periphery and at least one side face of the housing, the jacket (11, 12, 13, 14) being arranged in a spaced relationship relative to an outer surface of the periphery and at least one side face of the housing to define a fluid path about the outer surface of the housing, the fluid path having a fluid inlet (13) and a fluid outlet (14) adapted for connection to an engine cooling system such that the fluid flow path is pressurized, in use (See Figure, and Column 2, lines 13-40).

Note that in claim 1, the limitation "adapted for connection to an engine cooling system such that the fluid flow path is pressurized, in use" is an intended use recitation. A recitation of the intended use of the claimed invention must result in a structural

difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCCPA 1963).

Additionally, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

It is noted that in claim 1 the claim language "adapted to" makes optional but does not limit the claim 1 to the structure of the "water jacket of the compressor housing". See *MPEP* §2106 II C.

***Claims 1-2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Griepentrog (Pub. Number EP 14941 A1).***

**Regarding claims 1-2**, Griepentrog discloses a component for a turbocharger, the component including:

a housing (3, 100) defining a chamber for a predetermined part of the turbocharger, the housing (3, 100) being a compressor housing of the turbocharger and having an air inlet (See arrow ↓ of Figure 1) for receiving uncompressed air and an air

outlet (See arrow ↑ of Figure 1) for discharging compressed air to an engine (Not shown); and

a jacket (8) surrounding a periphery and at least one side face of the housing, the jacket (8) being arranged in a spaced relationship relative to an outer surface of the periphery and at least one side face of the housing (3, 100) to define a fluid path about the outer surface of the housing, the fluid path having a fluid inlet (12, 14) and a fluid outlet (10) adapted for connection to an engine cooling system such that the fluid flow path is pressurized, in use;

in which the fluid path (8) has the fluid outlet (10) situated at a furthestmost position on the housing from the fluid inlet (12, 14) (See Figures 1-2, and Abstract).

Note that in claim 1, the limitation “adapted for connection to an engine cooling system such that the fluid flow path is pressurized, in use” is an intended use recitation. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCCPA 1963).

Additionally, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed

apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

It is noted that in claim 1 the claim language “adapted to” makes optional but does not limit the claim 1 to the structure of the “water jacket of the compressor housing”. See *MPEP* §2106 II C.

**Regarding claim 5**, Griepentrog discloses a turbocharger including a component comprising:

a housing (3, 100) defining a chamber for a turbocharger compressor, the housing having an air inlet (See arrow ↓ of Figure 1) for receiving uncompressed air and an air outlet (See arrow ↑ of Figure 1) for discharging compressed air to an engine (Not shown); and

a jacket (8) surrounding a periphery and at least one side face of the housing, the jacket (8) being arranged in a spaced relationship relative to an outer surface of the periphery and at least one side face of the housing to define a fluid path about the outer surface of the housing, the fluid path having a fluid inlet (12, 14) and a fluid outlet (10) adapted for connection to an engine cooling system such that the fluid flow path is pressurized, in use (See Figures 1-2, and Abstract).

Note that in claim 1, the limitation “adapted for connection to an engine cooling system such that the fluid flow path is pressurized, in use” is an intended use recitation. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably



distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCCPA 1963).

Additionally, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

It is noted that in claim 1 the claim language "adapted to" makes optional but does not limit the claim 1 to the structure of the "water jacket of the compressor housing". See *MPEP §2106 II C*.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***Claims 1-2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Pielstick***

***(Patent Number 2,682,365) or Griepentrog (Pub. Number EP 14941 A1), in view of Woollenweber et al. (Patent Number 5,870,894).***

The modified Pielstick/Griepentrog device discloses the invention as recited above; however, fails to disclose fluid path adapted for connection to an engine cooling system such that the fluid flow path is pressurized, in use.

Woollenweber teaches that it is conventional in the internal combustion engine art having a turbocharger, to utilize fluid path adapted for connection to an engine cooling system such that the fluid flow path is pressurized, in use (See Column 7, lines 20-22).

It would have been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized fluid path adapted for connection to an engine cooling system such that the fluid flow path is pressurized, in use, as taught by Woollenweber, to improve the efficiency of the modified Pielstick/Griepentrog device, since the use thereof would have cool down the compressed air before being delivered into the engine..

***Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Pielstick (Patent Number 2,682,365) or Griepentrog (Pub. Number EP 14941 A1), in view of Woollenweber et al. (Patent Number 5,870,894). And further in view of Johnston et al. (Patent Number 5,857,332).***

The modified Pielstick/Griepentrog device discloses the invention as recited above; however, Meiners fails to disclose the jacket being of aluminium and attached to the housing by welding.

Johnston teaches that it is conventional in the supercharged internal combustion engine art, to utilize the jacket being of aluminium and attached to the housing. (See Column 3, lines 45-50).

It would have been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized the jacket being of aluminium and attached to the housing, as taught by Johnston, to provide the light weight for the modified Pielstick/Griepentrog device.

Note that the claimed phrases “the jacket being attached to the housing by welding” are being treated as product by process limitation; that is, the jacket is formed to the housing by manufacturing, forming, casting, molding, shaping, punching and rolling. As set forth in MPEP 2113, product by process claims are NOT limited to manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 USC 102/103 rejection may be made and the burden is shifted to applicant to show an obvious difference. See MPEP 2113.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-2 and 4-5 have been considered but are moot in view of the new ground(s) of rejection.

In response to Applicants' arguments , on pages 5-6, applicants state that neither of the references discloses the feature of the inlet and outlet to the path adapted for connection to an engine cooling system, such that, in use, fluid in fluid path is pressurized.

The examiner respectfully disagrees. The reasons are being set forth in the rejection above.

Additionally, As applicants argues that a person of ordinary skill in the art would have the implicit understanding that fluid in the fluid path must be under pressure if the fluid path is connected to the engine cooling system, since the engine cooling system would be pressurized . Therefore, as the modified Pielstick/Griepentrog device has the inlet and outlet to the fluid flow path adapted for connection to the engine cooling system as taught by Woollenweber, the modified Pielstick/Griepentrog-and-Woollenweber is capable of performing the function of pressurizing the fluid in the fluid flow path (*emphasis added*).

Accordingly, the rejections of claims 1-2 and 4-5 should be sustained.

#### ***Prior art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai-Ba Trieu whose telephone number is (571) 272-4867. The examiner can normally be reached on Monday - Thursday (6:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on (571) 272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TTB  
November 25, 2008

/Thai-Ba Trieu/  
Primary Examiner  
Art Unit 3748